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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,441	03/29/2001	Pat Odom	FEX001	1783

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EXAMINER

O CONNOR, GERALD J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/821,441**

Applicant(s)  
**Odom et al.**

Examiner  
**O'Connor**

Art Unit  
**3627**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on December 31, 2003 (Election and Amdt "B").
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 7-13 and 21-33 is/are pending in the application.
- 4a) Of the above, claim(s) 21-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on June 4, 2001 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 6) ☐ Other:

## **DETAILED ACTION**

### ***Preliminary Remarks***

1. This Office action responds to the amendment and election (reply to requirement for restriction) filed by applicant on December 31, 2003 (Paper N<sup>o</sup> 10) in reply to the Office action mailed December 1, 2003.

2. The cancellation of non-elected claims 1-6 and 14-20 by applicant in Paper N<sup>o</sup> 10 is hereby acknowledged.

3. The amendment of claims 7 and 8 by applicant in Paper N<sup>o</sup> 10 is hereby acknowledged.

4. The addition of claims 21-33 by applicant in Paper N<sup>o</sup> 10 is hereby acknowledged.

### ***Election/Restriction***

5. Applicant's election without traverse of the invention of Group II, claims 7-13, in Paper N<sup>o</sup> 10 is hereby acknowledged.

6. Newly submitted claims 21-33 are directed to an invention (Invention IV) that is independent or distinct from the invention originally elected (Invention II) for the following reasons:

Invention II is related to Invention IV as combination and subcombination. Inventions in this relationship are distinct if it can be shown that: (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, *and* (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In this case, the combination as claimed does not require the particulars of the subcombination as claimed, because a system in accordance with Invention II need not include any scanning of the transaction document at the point-of-sale terminal. The subcombination has separate utility, such as for use in transactions requiring authorizations/verifications from the billers.

7. Since applicant has already received an Office action for the originally presented, elected invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, newly presented claims 21-33 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### ***Oath/Declaration***

8. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: the full name of each inventor (family name and at least one given name, without abbreviation, together with any other given name or initial) has not been set forth in accordance with 37 CFR 1.63(a)(3). See MPEP § 605.04(b).

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 7-10, 12, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Vak et al. (US 5,473,143).

Vak et al. disclose a method for processing an in-person bill payment at a point-of-sale location 26, 28, 34 (see, in particular, column 8, lines 11-16), comprising: identifying a biller for whom payment of a payment transaction is to be received (inherent in sending the message); obtaining transaction information concerning the payment and receiving the payment (see, for example, column 11 at line 32); assigning a transaction identifier to the transaction (see, in particular, column 13, line 49 et seq., regarding logging of each transaction, as well as column 18, lines 39-67); scanning at least one transaction document and generating at least one electronic image therefrom (see, in particular, column 10, line 42 et seq.); storing each electronic image in an image memory 174 with an image identifier linked to a transaction identifier (inherent, as the system "knows" where the image is stored and to which transaction the image pertains); transmitting the transaction information to a payment server 52; receiving from the payment server instructions regarding the transaction (see, in particular, column 6, lines 29-39);

and, transmitting to an image server 120 a copy of each electronic image and its image identifier and linked transaction identifier.

Regarding claim 8, the method of Vak et al. further comprises storing the transmitted transaction information in a transaction database 232; storing the transmitted electronic image and identifiers in an image database 126; and, forwarding selected transaction information and at least a portion of the received payment to the biller (i.e. paying the bill).

Regarding claim 9, the method of Vak et al. further comprises detecting magnetically stored information located on the at least one transaction document and converting the magnetically stored information into electronic transaction information (see, in particular, column 11, line 14 et seq.).

Regarding claim 10, the method of Vak et al. further comprises generating transaction information from the electronic image through optical character recognition (see, in particular, column 10, line 42 et seq.).

Regarding claims 12-13, the method of Vak et al. further comprises receiving from the payment server additional system update instructions (see, in particular, column 19, lines 6-15) that include a list of billers for whom in-person bill payment is authorized (since the bills are paid via messages to biller addresses and the biller addresses can be stored/updated as message address information on card 48 via system update instructions received from server 52).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vak et al. (US 5,473,143), in view of Graves et al. (US 5,652,802).

Vak et al. disclose a method for processing an in-person bill payment at a point-of-sale location, including generating transaction information from an electronic image through optical character recognition, as applied above in the rejection of claims 7 and 10 under 35 U.S.C. 102(b), but Vak et al. do not specifically disclose generating the transaction information by comparing the electronic image to a pre-stored template containing an expected electronic image. However, Graves et al. disclose a method of optical character generation that indeed comprises comparing the scanned electronic image to a pre-stored template containing an expected electronic image in order to identify and authenticate the scanned document (see, for example, the abstract). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Vak et al. so as to generate the transaction information by comparing the electronic image to a pre-stored template containing an expected electronic image, in accordance with the teachings of Graves et al., in order to identify and authenticate the scanned document.

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to the disclosure.

14. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(703) 305-1525**, and whose facsimile number is **(703) 746-3976**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

Inquiries of a general nature or simply relating to the status of the application should be directed to the receptionist, whose telephone number is **(703) 308-1113**.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at **(703) 308-5183**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (fax-back auto-reply receipt service provided). Mailed replies should be addressed to "Commissioner of Patents and Trademarks, Washington, DC 20231." Hand delivered replies should be left with the receptionist on the seventh floor of Crystal Park Five, 2451 Crystal Dr, Arlington, VA 22202.

GJOC

January 12, 2004



Gerald J. O'Connor

Patent Examiner

Group Art Unit 3627